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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91167207
Party	Defendant DVD WORLD Pictures Corp.
Correspondence Address	Erik M. Pelton Erik M. Pelton & Associates, PLLC P.O. Box 100637 Arlington, VA 22210 UNITED STATES uspto@tm4smallbiz.com
Submission	Brief on Merits for Defendant
Filer's Name	Mark L. Donahey
Filer's e-mail	uspto@tm4smallbiz.com
Signature	/markldonahey/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MS. ANITA DHALIWAL
Opposer,

v.

DVD WORLD Pictures Corp.,
Applicant.

Opposition No. 91167207

Application Serial No. 78495856

Mark:

DVD World

APPLICANT'S TRIAL BRIEF

ERIK M. PELTON
ERIK M. PELTON & ASSOCIATES, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089
EMAIL: uspto@tm4smallbiz.com

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Applicant DVD WORLD Pictures Corp. (“Applicant”), by counsel, respectfully submits this trial brief in support of its application for registration of the mark DVD WORLD, shown in application Serial No. 78/495856 and opposed by Ms. Anita Dhaliwal (“Opposer”).

DESCRIPTION OF THE RECORD

The testimony detailed below has been made of record by the parties. Note that Opposer’s Brief does not attempt to strike any of the testimony filed by Applicant.

Pleadings

- Notice of Opposition filed October 27, 2005
- Answer filed December 7, 2005

Application file for Serial No. 78/495,856

Opposer’s Evidence

- **Opposer’s October 14, 2009 testimony deposition of Applicant’s Principal Edwin Papetti (“Papetti Dep.”), and exhibits thereto:**
 - Exhibit 2: Document with Xbox name
 - Exhibit 3: Printout from DVD World Company website
 - Exhibit 5: List of Domain Names with "DVD World"
 - Exhibit 23: Domain Name
 - Exhibit 24: Resale certificate
 - Exhibit 25: Business certificate
 - Exhibit 26: Yearbook ads
 - Exhibit 27: Copy of contract with Centereach High School
 - Exhibit 28: Various advertisements for DVD World Home Video recorded events
 - Exhibit 29: Advertisement for sale of book
 - Exhibit 30: Advertisement for company and services
 - Exhibit 31: Web page advertisement of movie from DVD World Pictures
 - Exhibit 32: Early home pages for main retail site
 - Exhibit 33: Printout from DVDWorldCompany.Com website
 - Exhibit 34: Page from the DVDWorldHomeVideo.Com website
 - Exhibit 35: Printout from DVD Destination site
 - Exhibit 36: Trademark papers
 - Exhibit 37: Printout from music retail site
 - Exhibit 38: Press release for book entitled "The Rape of America's Youth"

- Exhibit 39: Page from HDDVDWorld.Com before release of the HD DVD format
 - Exhibit 40: MySpace page
 - Exhibit 41: Archival posts from original DVD World site that was hosted by AOL
 - Exhibit 42: VHS cover for Dawnwood Blues
 - Exhibit 43: Principal Domain Name List
 - Exhibit 44: Trademark paper for DVD World mark
- **Opposer’s November 12, 2009, testimony deposition of Opposer’s Witness Dave Lahoti (“Lahoti Dep.”), and exhibits thereto:**
 - Exhibit 1: Letter dated 11-22-04 to DN Manager from DVD World Company Legal Department
 - Exhibit 2: Printout from www.thedvdworldcompany.com
 - Exhibit 4: Printout from www.dvdworldonline.com
 - Exhibit 5: List of Domain names that include “DVD” and “World”
 - Exhibit 65: Advertisement for “DVD World” of Corvallis, Oregon¹

Applicant’s Evidence

- **Applicant’s First Notice of Reliance, filed February 2, 2010**
 - Exhibit 1: Opposer’s Responses and Objection to Applicant 1st Interrogatories to Opposer Nos. 1, 2, 3, 4, 5, 6, 8, 9, 10, 11, 13, 17, 23, 26, 34, 35 and 36
 - Exhibit 2: Opposer’s Responses and Objections to Applicant’s First Set of Requests for Admissions Nos. 5 and 6
 - Exhibit 3: Third Party Federal Trademark Registrations on the U.S.P.T.O. Principal Register for marks in International Class 41 containing “WORLD” without a disclaimer of the term
 - Exhibit 4: Status and title copy of U.S. trademark registration number 2,912,970 owned by Applicant DVD World Pictures Corp. for the mark DVD WORLD & Design
 - Exhibit 5: Entity information for Applicant DVD World Pictures Corp. from the Department of State for the state of New York
- **Applicant’s Second Notice of Reliance, filed February 22, 2010**
 - Exhibit 6A: *Lahoti v. Vericheck, Inc.* 586 F. 3d 1190, 1203-1204 (9th Cir. 2009) - Ninth Circuit Opinion
 - Exhibit 6B: *Lahoti v. Vericheck, Inc.* - W.Dist. of WA. Order
 - Exhibit 6C: *Lahoti v. Vericheck, Inc.* - W.Dist. of WA. Findings of Fact and Conclusion of Law
 - Exhibit 6D: *Lahoti v. Vericheck, Inc.* - Bench Trial Transcript of Proceedings
 - Exhibit 7: TARR printouts from uspto.gov showing Opposer’s brother, David Lahoti or Opposer’s relative Ravi Lahoti, or a relative or alias of these persons, as owner of

¹ Applicant has moved to strike this document and related testimony as improper because it was clearly responsive to Applicant’s discovery requests yet not produced until the testimony period. See page 9 herein.

- more than 25 abandoned trademark applications.
 - Exhibit 8A: Records from WIPO Arbitration and Mediation Center Case No. D2000-0110
 - Exhibit 8B: Records from WIPO Arbitration and Mediation Center Case No. D2003-0428
 - Exhibit 8C: Records from WIPO Arbitration and Mediation Center Case No. D2003-0797
 - Exhibit 8D: Records from WIPO Arbitration and Mediation Center Case No. D2008-1183
 - Exhibit 9A: *E-Stamp Corp. v. Lahoti* - Judgment on Court Trial and Permanent Injunction Exhibit
 - 9B: *E-Stamp Corp. v. Lahoti*- Findings of Fact and Conclusion of Law Presented by Plaintiff E-Stamp Corporation
- **Applicant's Third Notice of Reliance, filed March 22, 2010**
 - Exhibit 10: Publications showing the WHOIS registration information for certain internet domain names (10A-10H)
 - Exhibit 11: Historical WHOIS registration information for the domain names dvdworld.com and vericheck.com. (11A-11R)
- **Applicant's March 16, 2010, Testimony deposition of Opposer Anita Dhaliwal ("Dhaliwal Dep."), and exhibits thereto:**
 - Exhibit A: Notice of Opposition
 - Exhibit B: Applicant's 1st Interrogatories
 - Exhibit C: Opposer's Responses and Objection to Applicant 1st Interrogatories
 - Exhibit E: Opposer's Responses to Applicant's 1st Request for Admissions
 - Exhibit G: Opposer's Response to Applicant's First Request for Production of Documents and Things
 - Exhibit H: Transfer of Domain Rights for dvdworld.com
 - Exhibit I: Notice of Testimony Deposition of Anita Dhaliwal

STATEMENT OF ISSUES

- I. Whether Opposer, an individual named Anita Dhaliwal, has proven she has standing to oppose registration of Applicant's DVD WORLD mark given that Ms. Dhaliwal (a) does not have a real ownership interest in the domain name upon which the notice of reliance is predicated, (b) Opposer has never competed with Applicant's services nor demonstrated any real intent to compete with Applicant's services, and (c) the relief requested would not provide redress to Opposer given Applicant's ownership of prior Registration No. 2,912,970 for the mark DVD WORLD & Design.

If Opposer satisfies the standing requirement,

- II. Whether Opposer has proven that Applicant's "DVD WORLD" mark is merely descriptive and should be denied registration under Trademark Act § 2(e)(1).
- III. Whether Opposer has proven that Applicant has failed to use its DVD WORLD mark as a trademark for any of the services in the application.

BACKGROUND

Applicant's Business under the DVD WORLD Mark

On or around 1997, Applicant's principal, Edwin Papetti launched The DVD World Company, a business for providing online sales of movie and video games, as well as live event recording and DVD creation. Papetti Dep. 28:21-30:9. Since then, Mr. Papetti's DVD World Company has created and managed a variety of DVD and movie websites and has sold thousands of DVDs per year. Papetti Dep. 30:20-31:9. In January 2003, Papetti filed to create DVD World Pictures Corp., a New York corporation. *See* Exhibit 5 attached to Applicant's First Notice of Reliance. Papetti operated DVD World Pictures Corp. as a division owned by the parent sole proprietorship DVD World Company. Papetti Dep. 16:16-23.

Applicant's Trademark Filings

On August 18, 2003, Applicant DVD World Pictures Corp., under Mr. Papetti's direction and signature, filed a trademark application seeking registration of the DVD WORLD & design mark shown below for use in connection with "Online Retailing of DVDs." On December 21, 2004, the USPTO granted Registration No. 2,912,970 (hereafter, "the '970 registration") to Applicant DVD World Pictures Corp., for the below mark with the wording "DVD" disclaimed. *See* Applicant's First Notice of Reliance, Exhibit 4. The '970 registration continues to be a valid registration today. *Id.*

Registration No. 2,912,970
DVD WORLD & Design



Id.

On October 6, 2004, Applicant DVD WORLD Pictures Corp. filed trademark application Serial No. 78/495,856 (hereafter, “the ‘856 application”) for the DVD WORLD mark in standard characters for use in connection with “Online Retail store services and distributorships of DVD movies” in International Class 35 and “Motion Picture Production and Distribution” in International Class 41. On May 11, 2005, in response to refusals issued by the Examining Attorney, Applicant disclaimed the descriptive wording “DVD” and notified the Examining Attorney that it was the owner of the cited ‘970 registration on May 11, 2005. On September 7, 2005, the ‘856 application was published for opposition. Applicant’s ‘856 application is the subject of the instant opposition proceeding.

Opposition Proceeding

On October 27, 2005, Opposer Anita Dhaliwal, an individual, allegedly filed a Notice of Opposition opposing registration of Applicant’s DVD WORLD mark for all classes of services identified in the ‘856 application. *See* Notice of Opp. As grounds for the opposition, Ms. Dhaliwal alleged that she was the owner of the domain name *dvdworld.com* and that she would therefore be harmed by the registration of Applicant’s DVD WORLD mark. Notice of Opp. ¶1. Opposer’s Notice of Opposition alleged that: (I) Applicant’s mark lacked distinctiveness and was merely descriptive; (II) Applicant fraudulently claimed use in connection with “Motion Picture Production and Distribution” services in Class 41; (III) Applicant was not using the applied-for mark as a trademark; (IV) Applicant had misused the ® notice in connection with the applied-for mark; and (V) Applicant had failed to disclaim the descriptive wording “DVD”. *See* Notice of Opp.

The discovery period in this proceeding commenced on November 18, 2005. Docket Doc. 2. Opposer served Requests for Admissions, Requests for Production of Documents, and

Interrogatory Requests in January 2006. Applicant responded to Opposer's Interrogatories and Requests for Admissions on February 17, 2006 and Opposer's Requests for Production on April 28, 2006. On May 17, 2006, Applicant its First Interrogatories, First Requests for Admissions, and First Requests for Production of Documents on Opposer. Opposer responded to each of Applicant's discovery requests on June 16, 2006, and the discovery period closed on May 17, 2006. Docket Doc. 2. Opposer's Interrogatory Responses stated that Ms. Dhaliwal was an individual owner of the dvdworld.com domain name, that there were no other owners of the domain name, and she had not engaged in any business connected with the domain name relating to the services identified in the '856 application. *See* Opposer's Response to Applicant's First Interrogatory Requests Nos. 1, 2, and 5, Applicant's First Notice of Reliance, Exhibit 1. Furthermore, Applicant did not produce any documents in response to Applicant's Requests for Production of documents, and no otherwise responsive documents were produced by Opposer prior to the testimony period.

Opposer's testimony period commenced July 17, 2006. Docket Doc. 2. However, on July 17, 2006, Opposer attempted to file a motion for summary judgment. Docket Doc. 8. On July 18, 2006, the Board denied the motion for failure to comply with Trademark Rule 2.127(e), precluding parties from filing a motion for summary judgment after the commencement of the first testimony period. Docket Do. 9. On July 20, 2006, Opposer filed a Motion for Reconsideration resulting in suspension of the proceeding pending a decision of the motion on July 28, 2006. Docket Docs 10 & 11. On July 18, 2007, the Board denied the Motion for Reconsideration and reset the testimony periods. Docket Doc. 13.

On September 5, 2007, during Opposer's resumed testimony period, Applicant's former counsel moved to withdraw from its representation of Applicant, resulting in an additional

suspension. Docket Doc. 14. Opposer's testimony period ultimately resumed in October 2009, after further delays resulting from two additional untimely motions for summary judgment filed by Opposer and Applicant (without aid of counsel), the appearance of Applicant's present counsel on April 15, 2009, and stipulated extensions by the parties. Docket Doc. 27.

During Opposer's testimony period, Opposer took the testimony depositions of Applicant's Principal Edwin Papetti on October 14, 2009, and Opposer's brother Dave Lahoti on November 12, 2009. During Applicant's testimony period, Applicant filed three notices of reliance and took the testimony deposition of Opposer Anita Dhaliwal on March 16, 2010. Opposer's rebuttal period ended on May 14, 2010, without further action from Opposer. Opposer filed her brief on the merits on July 9, 2010. Docket Doc. 42.

Testimony of Dave Lahoti and Anita Dhaliwal

During Opposer's testimony deposition of Opposer's brother Dave Lahoti on November 12, 2009, Mr. Lahoti testified that he had purchased the dvdworld.com domain name in 2004 in his own name for \$20,100 with the use of his sister Anita Dhaliwal's credit card, and he later repaid the full purchase price to her. Lahoti Dep. 6:25-7:9. Mr. Lahoti testified that he had personal ownership of the domain name, which he later transferred to his corporation, Virtual Point, in 2007. Lahoti Dep. 24:5-16. According to Lahoti's testimony, Virtual Point was still the owner of the dvdworld.com domain name as of his November 12, 2009 deposition, and Mr. Lahoti was the sole owner and officer of the corporation at that time. Lahoti Dep. 22:11-25. Finally, Mr. Lahoti testified that he retained counsel for this proceeding and continued to be counsel's the primary contact. Lahoti Dep. 29:16-22; 30:18-20.

At the conclusion of Opposer's testimony deposition of Dave Lahoti, Applicant's counsel expressed concern that much of what Mr. Lahoti had described about the ownership of the

dvdworld.com domain name was in direct contradiction with Opposer Dhaliwal's responses to Applicant's discovery requests. Lahoti Dep. 30:5-31:1; 55:19-56:13. For example, Opposer's Interrogatory Responses identified only Anita Dhaliwal as the sole and individual owner of the dvdworld.com domain name, and they failed to identify any other entities with any interest in Opposer's business involving Opposer's domain name or alleged mark. *See* Opposer's Response to Interrogatories Nos. 1 and 2, Applicant's First Notice of Reliance, Exhibit 1. Subsequently, Opposer produced a document signed by Dave Lahoti and dated January 6, 2010, in which Mr. Lahoti's company Virtual Point purported to transfer to Opposer Anita Dhaliwal a 25% interest in the ownership of the dvdworld.com domain name. Dhaliwal Dep. Exhibit H. The document was not signed by Ms. Dhaliwal herself. *Id.*

During Applicant's subsequent testimony deposition of Opposer Anita Dhaliwal on March 16, 2010, Ms. Dhaliwal testified that she first learned about this opposition proceeding upon receiving notice of her testimony deposition, more than four years after the filing of the Notice of Opposition. Dhaliwal Dep. 38:22-25. She also testified that she was unaware of who initiated the current proceeding before the Board. Dhaliwal Dep. 38:19-21.

APPLICANT'S MOTION TO STRIKE

As a preliminary matter, Applicant moves to strike evidence produced by Opposer for the first time during discovery despite Opposer's denial that such evidence existed in response to Applicant's discovery requests and despite Opposer's failure to supplement discovery responses prior to the commencement of Opposer's testimony period. Applicant also moves to strike Opposer's testimony related to such evidence and to disregard portions of Opposer's Brief relying on or discussion the evidence or testimony relating to the stricken evidence.

A party may not withhold documents requested or fail to make a complete investigation to locate information. *Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (CCPA 1987). Furthermore, a party may not use its failure to satisfy its discovery duties to the prejudice of its adversary. *Shoe Factory Supplies Co. v. Thermal Engineering Co.*, 207 USPQ 517, 519 fn.1 (TTAB 1980)(“[A] party may not properly introduce a document in evidence in its behalf after having refused to make it available to an adverse party seeking discovery thereof...”); *Grow Company, Inc. v. Biotest Labs, LLC*, 2004 TTAB LEXIS 25 at *9-11 (TTAB Jan. 22, 2004)(refusing as an “unfair surprise” admission into evidence of materials falling within the scope of discovery requests when the party offering the evidence “did not indicate in its discovery answers that any other materials were available, but were being withheld”); TBMP § 408.02.

During Opposer’s November 12, 2009, testimony deposition of Applicant’s principal Edwin Papetti, Opposer produced for the first time a previously undisclosed advertising flyer purporting to show the use of “DVD WORLD” by a third-party in Corvallis, Oregon (hereinafter “Corvallis Ad”). See Exhibit 30 to Papetti Dep.² Applicant moves to strike the Corvallis Ad pursuant to TBMP §§ 532 and 704, 37 CFR § 2.120(j) because it was improperly withheld in response to Applicant’s discovery requests.

The Corvallis Ad was responsive to Applicant’s discovery requests, but was not produced, and Opposer has no reason to believe it was being withheld. Applicant’s Request for Production of Documents No. 26 requested “All documents referring or relating to uses known to Opposer by persons other than itself of a mark or domain name containing the word “DVD WORLD” or any variants thereof.” See Opposer’s Response to Applicant’s First Request for

² The exhibit was also attached to the Lahoti Dep. as Exhibit 65, and was served on Applicant on December 21, 2009, after the close of Opposer’s testimony period.

Production of Documents and Things, No. 26, attached as Exhibit G to Dhaliwal Dep. Opposer responded to this request on June 16, 2006, stating “Subject to and consistent with all of its objections, Opposer hereby produces, where appropriate, non-privileged, responsive documents in its possession, custody, and control.” *Id.* During discovery, Opposer did not produce the Corvallis Ad nor inform Applicant that any such document existed.

More than three years after Opposer’s discovery responses, Opposer introduced the Corvallis Ad during the testimony deposition of Dave Lahoti, and Applicant’s counsel objected to the admission of the previously withheld Corvallis document and to the lack of foundation. Lahoti Dep. 10:4-22; 11:5-7. Furthermore, Lahoti stated in the deposition that he first located the Corvallis Ad in early 2005. Lahoti Dep. 11:13-21.

Applicant would be prejudiced by introduction of the Corvallis Ad because Applicant was not given the full opportunity to investigate the document, to determine the source of the document, to determine how when, if, and where the document was actually used, to depose the creator of the document, to determine whether the document is still in use, or to verify the accuracy of the document.

Furthermore, the Corvallis Ad is improper because it has not been properly authenticated. It is not a business record belonging to Opposer or Applicant, nor an official record, nor competent evidence of a printed publication. 37 CFR §2.122(e). Testimony deposition portions offered by Opposer regarding the Corvallis Ad do not establish where, when, and how the Corvallis Ad was obtained, any chain of custody, who created and printed the Corvallis Ad, what publication or publications displayed the Corvallis Ad, or when the Corvallis Ad was created or published.

Applicant here “had no reason to believe that Opposer’s production was anything other

than a complete and good faith effort to meet applicant's discovery requests." *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, Oppositions Nos. 91174767 and 91174768 (December 29, 2009) (opposer produced some responsive documents from a public library during discovery, but similar documents produced for the first time after the discovery period were stricken).

Each party has a duty to "make a good faith effort to satisfy the discovery needs of its adversary." *Id.* The Corvallis Ad, which Opposer attempts to introduce as evidence after disclosing its existence for the first time during testimony, was clearly responsive to Applicant's properly served discovery requests. Opposer never indicated it was withholding any responsive documents when it produced document requests responses on June 16, 2006, and allowing the Corvallis Ad into testimony would unfairly prejudice Applicant by denying Applicant the opportunity to obtain additional discovery related to the documents. See *Weiner King, Inc. v. The Weiner King Corporation*, 615 F.2d 512, 204 USPQ 820, 828 (CCPA 1980).

Wherefore, Applicant moves to strike the (a) Corvallis Ad at Exhibit 30 to Papetti Dep. and at Exhibit 65 to Lahoti Dep.; and (b) all testimony by Opposer's witness regarding the documents, namely Papetti Dep. 23:1-24:6; Lahoti Dep. 10:11-12:2.

PROCEDURAL EXCLUSIONS

Opposer raised several unpleaded issues in her trial Brief. These claims must be dismissed as improperly raised for the first time in Opposer's Brief. In addition, several claims raised by Opposer in her Notice of Opposition are absent from Opposer's Brief. These claims must be dismissed as conceded.

a. Issues argued in Brief but not pleaded by Opposer.

A plaintiff may not rely on an unpleaded claim. The plaintiff's pleading must be amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter. Opposer attempts to raise several issues in its Brief for the first time. Because Opposer has failed to properly plead said issues or to amend its pleading, these claims must be dismissed by the Board.

Opposer's allegations of fraud raised for the first time in its brief on the merits must fail because they were not pleaded in the Notice of Opposition and they are not supported by the evidence. Opposer's brief alleges that allegedly false statements regarding dates of first use and lack of use for sale of DVDs are grounds for refusal of Applicant's mark. Opp. Brief Part III.E. Yet the issue was not pleaded in Opposer's Notice of Opposition, and was certainly not pleaded with the specificity required for fraud.

[T]he circumstances constituting the alleged fraud shall be stated with particularity...

The circumstances referred to in Federal Rule 9 "'must be pleaded in detail'— '[t]his means the who, what, when, where, and how' of the alleged fraud." That is, the time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. *See W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 672 (Comm'r Pat. 1977); and *Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964). *See also San Juan Products, Inc. v. 68 San Juan Pools of Kansas, Inc.*, 849 F.2d 468, 7 USPQ2d 1230, 1234 (10th Cir. 1988) (The elements for fraud that must be alleged and proven are: "(1) the false representation regarding a material fact; (2) the registrant's [or applicant's] knowledge or belief that the representation is false (scienter); (3) the intention to induce action or refraining from action in reliance on the misrepresentation; (4) reasonable reliance on the misrepresentation; and (5) damages proximately resulting from such reliance" (internal citation omitted)). Additionally, the pleadings must allege sufficient underlying facts from which a tribunal may reasonably infer that a party acted with the requisite state of mind.

E.&J. Gallo Winery v. Quala S.A., Opposition No. 91186763 (November 7, 2009) (some internal citations omitted).

The Notice of Opposition did not allege that Applicant's dates of first use were false or that Applicant was not engaged in the distribution of DVDs. While the Notice of Opposition, in ¶¶ 7-9 alleges that Applicant is not engaged in "motion picture production and distribution," this statement in the Notice of Opposition relates to different services and does not meet the requirements for pleading fraud. Furthermore, Opposer concedes in her Brief that Applicant is engaged in motion picture production. Opp. Brief p. 3. As a result, any allegation of fraud has not been sufficiently proven nor sufficiently pleaded by Opposer and should be denied and dismissed.

Similarly, Opposer's assertions that the opposed application is void *ab initio* for an alleged failure to correctly identify the owner of the mark (Opp. Brief at p. 18, n. 6) or that Applicant has abandoned the mark (Opp. Brief at p.12) were not pleaded in the Notice of Opposition and should not be considered. See Docket Doc. 1. Even if these issues were properly pleaded, Edwin Papetti is clearly the controlling owner and officer of Applicant DVD World Pictures Corp. as well as several related entities. *See Argument, Sec. III*, herein. Any use of the DVD WORLD mark by Papetti or related entities inures to the benefit of Applicant. *Id.*

b. Issues pleaded but absent from Opposer's Brief.

Opposer's Brief also concedes several pleaded issues which are not referenced at all in her Brief. Grounds for opposition which are pleaded but not raised in the plaintiff's final brief on the merits are waived. TBMP § 1203.02(g); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948,1950 n.2 (TTAB 2001) (applicant did not, in its appeal brief, pursue claim of inherent distinctiveness, and therefore the claim was not considered by Board). Opposer's pleaded claim of fraud for lack of use on motion picture production and distribution as alleged in Notice of

Opposition ¶¶ 7-9 was not argued in Opposer's Brief and is therefore waived. Furthermore the fraud claim was not properly pleaded or proven under the post-*Bose* standards.

Opposer's pleaded claim that Applicant has misused the registration notice symbol (®), Notice of Opposition ¶¶ 17-18, was not argued in Opposer's Brief and is therefore waived as well.

Opposer's claim, at Notice of Opposition ¶¶ 20-23, that Applicant failed to disclaim "DVD" is on its face improper because "DVD" was clearly disclaimed. *See* Application record. In addition, the claim was not argued in Opposer's Brief and is therefore waived. TBMP § 1203.02(g).

Wherefore, each of the foregoing claims presented by Opposer must be dismissed because they were either raised for the first time in Opposer's Brief having never been pleaded, or because they were pleaded but not argued in Opposer's Brief.

SUMMARY OF ARGUMENT

First, Opposer Dhaliwal has failed to meet her burden to demonstrate standing to oppose the mark in this proceeding because she has not demonstrated a real ownership interest in the domain name upon which the opposition is predicated, nor has Opposer Dhaliwal demonstrated that she has ever competed with Applicant's services or documented any real intent to compete with Applicant's services. Furthermore, the relief requested by Opposer Dhaliwal would not provide redress given Applicant's ownership of Registration No. 2,912,970 for the mark DVD WORLD & Design and Opposer Dhaliwal's lack of ownership of the dvdworld.com domain name.

Second, Opposer has not proven by a preponderance of the evidence that Applicant's

mark is descriptive. Opposer's evidence is extremely limited, the meaning of the terms "WORLD" in the context of Applicant's mark is suggestive and supported by numerous third party registrations, and Applicant's mark has acquired distinctiveness as a result of more than 10 years of use and prior registration of a logo containing the same "DVD WORLD" wording.

Finally, Opposer's allegation that Applicant has failed to use its DVD WORLD mark as a trademark for services in the application is clearly controverted by the evidence of record.

ARGUMENT

I. Opposer Anita Dhaliwal lacks standing to oppose Applicant's DVD WORLD mark.

A party has standing to oppose a registration under Section 13 of the Lanham Act, 15 U.S.C. §1063, if that party can demonstrate that it has a real interest in the proceeding (i.e., a direct and personal stake in the outcome of the proceeding). *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-1026 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Moreover, "[l]ack of standing' is not an affirmative defense; rather, standing is an essential element of petitioner's case which, if it is not proved at trial, defeats petitioner's claim." *Nobelle.com, LLC v. Qwest Communications International, Inc.*, 66 U.S.P.Q.2d 1300, 1303 (2003) (citing *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (CCPA 1992)). Standing is a requisite element that requires a showing that the opposer would be damaged by registration of the proposed mark. 37 C.F.R. §2.104(a). "Opposer's burden of proof includes establishing his standing to bring the claim. This threshold inquiry is made by the Board in every inter partes case." *Ronald N. Myers v. David Gilbert*, Opposition No. 91182094 at *3 (TTAB 2008). Here, Opposer cannot meet the requirements for standing to oppose Applicant's mark.

A. Opposer Dhaliwal has not proven her ownership of the dvdworld.com domain name upon which her claim of standing is based

The Notice of Opposition is predicated on the claim that Anita Dhaliwal, an individual, allegedly owns the dvdworld.com domain name, and the assertion that she would therefore be damaged by registration of Applicant's mark. *See* Notice of Opposition Oct. 27, 2005 at ¶2.

As grounds for opposition, Opposer alleges that:

1. Since at least as early as November 29, 2004, Opposer has owned the domain name DVD WORLD in connection with the sale of DVDs.
2. As Opposer is the owner of the domain name www.dvdworld.com, Opposer will be damaged by the issuance of a registration for DVD WORLD to Applicant as sought in Application Serial No. 78495856. Opposer opposes the registration of the mark based on the following grounds:

See Notice of Opposition. ¶¶1-2.

Opposer Dhaliwal produced no documentation or testimony demonstrating such ownership. During discovery, Opposer Dhaliwal acknowledged that she possessed no documents regarding any assignment of the domain name.

REQUEST FOR PRODUCTION NO. 10

All documents referring or relating to Opposer's licensing or assignment of the right to use Opposer's Domain Name and/or Related Marks to another person or entity, including but not limited to all licenses.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10

Opposer incorporates its General Objections into this response. Opposer further objects to this Request as vague, ambiguous, overly broad and unduly burdensome to the extent it seeks the production of documents that are neither relevant nor reasonably calculated to lead to discovery of admissible evidence. Subject to and consistent with all of its objections, Opposer states there are no such documents in its possession, custody, or control.

See Opposer's Response to Applicant's First Request for Production of Documents and Things No. 10, Dhaliwal Dep. Exhibit G.

However, the testimony detailed below from Opposer Dhaliwal and her brother, David Lahoti, demonstrates that Opposer Dhaliwal did not have any ownership interest in the dvdworld.com domain name at the time this proceeding was initiated. Furthermore, Opposer Dhaliwal's only alleged interest in the dvdworld.com domain name today comes from a purported assignment of a partial interest executed during the testimony period of this proceeding.

According to the testimony of both Opposer and Opposer's witness, Opposer Dhaliwal assisted her brother Dave Lahoti in purchasing the dvdworld.com domain name in 2004, through the use of her credit card for payment. Dhaliwal Dep. 30:5-9. Lahoti paid her back in full within a month, however, and Lahoti thus became the sole owner of the dvdworld.com domain name.

13	Q	Were you using an account under your sister's
14		name, if there was one auction account?
15	A	It was my sister's -- I think it was her
16		credit -- maybe her credit card and it was my user name.

Lahoti Dep. 26:13-16.

8	Q.	And were you repaid for the amount that
9		you paid for the domain name?
10	A.	Yes.
11	Q.	Were you repaid in full?
12	A.	Yes.
13	Q.	And who paid you?
14	A.	Dave Lahoti.
15	Q.	And when did he pay you?
16	A.	I recall within a month's time.

Dhaliwal Dep. 31:8-16.

Opposer Dhaliwal did not purchase the domain name, but merely loaned her brother Dave Lahoti funds so he could purchase the dvdworld.com domain name. Opposer has not produced any evidence, apart from self-serving testimony, that she had any ownership rights in the domain name. Furthermore, Lahoti testified that he alone had personally owned the dvdworld.com domain site before transferring ownership to his company, Virtual Point, in 2007.

5 Q And when did Virtual Point take ownership of
6 the dvdworld.com domain name?

7 A Soon after I formed Virtual Point in 2007.

8 Q And who initiated that transaction?

9 A I did.

10 Q And was there any change -- was there any
11 written agreement involved in that transaction?

12 A No. Just reorganized all my sole proprietor
13 operations into Virtual Point.

14 Q Did you personally own the dvdworld.com domain
15 name prior to Virtual Point's owning it?

16 A Yes.

Lahoti Dep. 24:5-16

11 Q Who is the owner today of the dvdworld.com
12 domain name?

13 A My company, Virtual Point.

14 Q Is that a corporation?

15 A Yes, it is.

16 Q Is that a California corporation, do you know?

17 A Yes.

18 Q Do you have any other partners in that
19 corporation?

20 A No. Right now, as of -- now, no.

21 Q You're the sole officer of the corporation?

22 A As of now, yes.

23 Q Have you ever had other partners, officers or
24 investors?

25 A No. That company has been existing since 2007.

Lahoti Dep. 22:11-25.

Counsel for Applicant noted during Lahoti's deposition that the testimony regarding ownership of the domain name was inconsistent with discovery produced by Opposer and requested supplemental discovery regarding the issue. Lahoti Dep. 54:10-25. After Lahoti's testimony, on January 6, 2010, Opposer served applicant with a copy of a domain transfer agreement executed by Dave Lahoti. *See* Exhibit H to Dhaliwal Dep.

10	Q.	Do you know what this document does?
11	A.	Transfer of domain name rights.
12	Q.	So this document transfers to you a 25
13		percent ownership interest in the domain name; is
14		that your understanding?
15	A.	Yes.
16	Q.	And you paid \$1 for this?
17	A.	Correct.
18	Q.	And you now own 25 percent of the DVD
19		World domain name?
20	A.	Correct.

Dhaliwal Dep. 69:10-25. This purported transfer, along with Opposer's testimony, demonstrates that prior to January 6, 2010, Opposer Dhaliwal had no ownership interest in the dvdworld.com domain names, and Opposer Dhaliwal had no standing at the time of filing the Notice of Opposition.

Because Opposer Dhaliwal is not the rightful owner of the dvdworld.com domain name today, due to this sham transaction, and Opposer Dhaliwal was not the owner of the dvdworld.com domain name when this proceeding was instituted, Opposer Dhaliwal does not have a real interest in the DVD WORLD mark, cannot be damaged by its registration, and does not have standing to oppose it.

The true owner of the dvdworld.com domain name is Dave Lahoti, an adjudicated cybersquatter who had motivation to conceal his involvement in this proceeding. The named Opposer, Anita Dhaliwal, through testimony and evidence has demonstrated her complete lack of

involvement with this Opposition. Specifically, Opposer Dhaliwal was not aware of the present Opposition against Applicant until she was called to testify.

19 Q. Now, who initiated this proceeding
20 before the TTAB?
21 A. I don't know.
22 Q. When did you first learn about this
23 proceeding that you are testifying for today?
24 A. When I was told that I'm going in for a
25 deposition.

Dhaliwal Dep. 38:19-25

Opposer Dhaliwal has acknowledged that she never saw any documents in this proceeding prior to her testimony (Dhaliwal Dep. 46-54) and that, until learning about her testimony deposition, she never spoke with her counsel who filed the Notice of Opposition, handled discovery, and filed motions and documents in this proceeding on her behalf.

3 Q. Did you ever speak with your attorney
4 about this case before learning about this
5 deposition?
6 A. I handled everything through Dave.
7 Q. So you didn't?
8 A. I handled everything through Dave.
9 Q. So does that mean that you personally
10 did not speak to your attorneys about this case
11 prior to learning about this deposition?
12 A. Correct.

Dhaliwal Dep. 50: 3-12.

Dave Lahoti, an adjudicated cybersquatter,³ has testified that he not only is the sole owner of dvdworld.com⁴, but also that he is the primary contact with counsel for Opposer

³ See e.g., opinion from the Ninth Circuit stating “[t]his case does not reflect the first time Lahoti has registered domain names that were similar to the names or trademarks of other companies. Lahoti had previously registered more than four hundred domain names containing the trademarks of other companies, including nissan.org, 1800 mattress.com, and ebays.com. In at least two cases, the United Nations World Intellectual Property Organization ordered Lahoti to give up control of some of his domain names because they infringed on a trademark. In 2000 the United States District Court for the Central District of California in *E-Stamp Corp. v. Lahoti* (the “E-Stamp Case”),

regarding this proceeding.⁵ Mr. Lahoti has also filed and abandoned multiple intent-to-use trademark applications with the USPTO.⁶ Until the testimony period of this proceeding, Opposer Dhaliwal had no ownership interest in the dvdworld.com domain – other than a brief re-paid loan – and had no knowledge of the proceeding itself, even during discovery. As a result, Opposer Dhaliwal has not proven that she has standing to oppose the application at issue. Her brother, Dave Lahoti, had clear motivation for filing an Opposer to make a claim on his behalf as his record as a cybersquatter could color any proceeding in which he was a party.

B. Opposer Dhaliwal does not have standing because she has failed to prove that she is a competitor in the sale of goods and services identified in the subject application, and the requested remedy does not provide redress for her asserted basis for standing.

Even if Opposer Dhaliwal is and was the owner of the dvdworld.com domain name, Opposer Dhaliwal has failed to document any plans or steps taken regarding use of DVD WORLD or dvdworld.com or that she is a competitor of Applicant in either the sale of DVD's or the production of motion pictures.

“To establish its standing to assert a mere descriptiveness or genericness ground of opposition or cancellation, ‘a plaintiff need only show that it is engaged in the manufacture or sale of the same or related goods as those listed in the defendant’s involved application or registration and that the product in question is one which could be produced in the normal expansion of plaintiff’s business; that is, that plaintiff has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively [or generically] in its business.’”

No. CV-99-9287, 2000 WL 33732808, concluded that Lahoti was a "cybersquatter" and that his registration, attempted sale, and use of the estamps.com domain name violated federal trademark law and the ACPA.” *Lahoti v. VeriCheck, Inc.*, 586 F. 3d 1190, 1203-1204 (9th Cir. 2009) (affirming the district court's grant of summary judgment that Lahoti acted in bad faith, stating “...it is undisputed that Lahoti is a repeat cybersquatter who has registered hundreds of domain names resembling distinctive or famous trademarks and has been admonished by judicial bodies for doing so.”) attached as Applicant’s Exhibit 6A to Applicant’s Second Notice of Reliance.

⁴ See Lahoti testimony 24:5-16.

⁵ Lahoti Dep. 30:18-20.

⁶ See Opposer’s Second Notice of Reliance at Exhibit 7 containing TARR printouts from uspto.gov showing Opposer’s brother, David Lahoti or Opposer’s relative Ravi Lahoti, or a relative or alias of these persons, as owner of more than 25 abandoned trademark applications.

Nobelle.com, LLC v. Qwest Communications International, Inc., 66 USPQ.2d 1300 (TTAB 2003) (citing *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984)). Opposer here has failed to demonstrate anything more than an idea that never came to fruition. Dhaliwal Dep. 86:9-15. In *Nobelle*, the Board determined that “incubating and developing” was not enough to grant standing. 66 USPQ.2d 1300. Here, Ms. Dhaliwal’s alleged initial concepts and ideas for retail sale of DVD - unsupported by any evidence of steps or actual plans - do not give her, as the Opposer, standing in this dispute.

Furthermore, Opposer Dhaliwal has not established that she has ever been the owner of the dvdworld.com domain name. No WHOIS domain records, receipts, or other tangible evidence showing Opposer Dhaliwal as the dvdworld.com domain name owner have been provided as testimony. Virtual Point, a company solely owned by Lahoti, is currently listed as the owner of the domain name. Applicant’s Third Notice of Reliance, Exhibit. 11. Opposer Dhaliwal has no role or interest in Virtual Point.

20	Q.	Do you have any role in Virtual Point?
21	A.	No.
22	Q.	You're not an owner?
23	A.	No.
24	Q.	You're not employed by Virtual Point?
25	A.	No.

Dhaliwal Dep. 65:20-25.

In her testimony and interrogatory responses, Opposer Dhaliwal admits that she has never sold any DVDs or produced/distributed any motion pictures under the dvdworld.com domain name or any other mark or domain name.

20 Q. Possibly. And did you ever sell DVD's
 21 through dvdworld.com?
 22 A. No.
 23 Q. Did you ever use dvdworld.com for any
 24 other purpose?
 25 A. No.

Dhaliwal Dep. 31:20-25.

Interrogatory 5

Identify and describe each product and/or service sold by Opposer in connection with Opposer's Domain Name and/or any Related Marks, including any products and/or services which are no longer offered by Opposer.

Response to Interrogatory No. 5

Opposer incorporates by reference its Preliminary Statement, General Objections, and Objections to the Definitions and instructions in the Interrogatories. Without waiving its objections, Opposer states that the www.dvdworld.com website has not been used to sell products or services during Opposer's ownership of the www.dvdworld.com website.

See Opposer's Response and Objections to Applicant's First Set of Interrogatories, Applicant's First Notice of Reliance, Exhibit 1.

In addition, Opposer Dhaliwal has failed to demonstrate any effort or plans to attempt to sell DVD related products. The dvdworld.com site, owned and operated by Virtual Point, is nothing more than a page that has been under construction since 2007 with no goods or services offered and no formal plans for development. Additionally, before 2007, the dvdworld.com site was inactive.

3 Q Does somebody for Virtual Point -- does Virtual
 4 Point, Inc., or one of its employees maintain the site
 5 at dvdworld.com?
 6 A Right. And, also, it's a "Coming Soon" page.
 7 Mainly, the dvdworld.com is a "Coming Soon" page.

Lahoti Dep. p. 41:3-7.

21 Q Do you know when this "Coming Soon" page at
22 dvdworld.com that is currently there was posted?

23 A Probably sometime in late 2007.

24 Q Do you recall what was there prior to this
25 page?

1 A I think it was inactive for a while, because of
2 this pending issue. So I left it inactive for a few
3 years. And then, when there was some comments about
4 changing counsel from Baker, or when they withdrew
5 counsel, then I didn't want to leave it inactive
6 anymore. I decided that I wasn't going to wait and
7 wanted to at least get a little start on it.

Lahoti Dep. 43:21-44:7.

Opposer Dhaliwal's failure to demonstrate her intent to use the DVD WORLD mark in any business weighs against a finding of a competitive relationship between Applicant and Opposer Dhaliwal. Neither Opposer Dhaliwal nor her brother Lahoti has shown any marketing or business plans or documented any intent to use the dvdworld.com domain.

14 Q Do you have any marketing plans for this
15 business?

16 A Basically, the same type of plans, which is
17 very informal type of plans, just as I did with
18 dvduniverse. So nothing formal. I don't -- I don't do
19 formal marketing plans.

20 Q So is there any kind of formal business plan or
21 other written plan that relates to your goals and ideas
22 for using dvdworld and dvdworld.com?

23 A No, nothing formal. Since this was brought to
24 my attention, this legal issue, then I had kind of put
25 that on hold.

1 Q Well, are there any informal memos or E-mails
2 or other documented details regarding those claims?
3 A No. In the last five years, this has been
4 pending, this matter, so I haven't invested any further
5 time in this until the outcome of this. So I have done
6 very scant -- my efforts have been very scant in this.

Lahoti Dep. 41:14 - 42:6.

Interrogatory 9

Identify all advertisements and promotions showing Opposer's Domain Name and/or any Related Marks in connection with Opposer's goods and services and indicate the date when each advertisement appeared, the medium or media in which the advertisements or promotions appeared, the geographic locations where such advertisements or promotions appeared, and the class of consumer or purchaser to whom each advertisement or promotion was directed.

Response to Interrogatory No. 9

Opposer incorporates by reference its Preliminary Statement, General Objections, and Objections to the Definitions and instructions in the Interrogatories. Without waiving its objections, Opposer states that Opposer has no advertisements or promotions concerning the www.dvdworld.com domain name.

See Opposer's Response and Objections to Applicant's First Set of Interrogatories, Applicant's First Notice of Reliance, Exhibit 1.

Opposer Dhaliwal has not demonstrated an interest in the dvdworld.com domain name at the time of the opposition filing, nor any participation in the case prior to her testimony deposition. Even if she were the owner of an interest in the dvdworld.com domain name, Opposer Dhaliwal has not demonstrated any intent to compete with Applicant or to offer any of services offered by Applicant. *See Nobelle.com, LLC v. Qwest Communications International, Inc.*, 66 USPQ.2d 1300 (TTAB 2003).

Finally, Opposer Dhaliwal has not demonstrated that the requested remedy addresses her claimed injury regarding the dvdworld.com domain name. Applicant is the owner of the '970

registration for the image below containing the wording DVD WORLD for use with “Online Retailing Of DVDs.”



See Applicant’s First Notice of Reliance, Exhibit 4. Opposer Dhaliwal has not filed to cancel the ‘970 registration. Even if Opposer were able to demonstrate that the pending application should be denied to Applicant, Opposer’s alleged harms and injuries would not be resolved as Applicant would still own its prior registration for related services which includes the terms “DVD WORLD” without any disclaimer of “WORLD.”

Opposer has also argued that registration of Applicant’s mark could subject Opposer Dhaliwal to lawsuits. Opposer’s Brief at p.18. However, a threat of suit based on the applied-for registration is not sufficient grounds for Opposition. See McCarthy, *Trademarks and Unfair Competition*, § 20:11 (4th ed. 2000).

In conclusion, Opposer Dhaliwal has failed to prove any personal stake in the proceeding, that she has any real or documented plans to compete with Applicant, or that refusal of the ‘856 application would provide redress for her claimed harm. Opposer Dhaliwal’s burden to show standing has not been met and the opposition must be denied.

II. Applicant’s DVD WORLD mark is not descriptive

Applicant’s ‘856 application should not be denied because the DVD WORLD mark is not merely descriptive. Under Section 2(e)(1) of the Trademark Act, “A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 UPSQ

1370, 1371 (Fed. Cir 2004), quoting, *Estate of P.D. Bechwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920); see also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ 1778, 1780 (Fed. Cir, 2003).

“Whether a given mark is suggestive or merely descriptive depends on whether the mark ‘immediately conveys...knowledge of the ingredients, qualities, or characteristics of the goods...with which it is used,’ or whether ‘imagination, thought, or perception is required to reach a conclusion on the nature of the good,’” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009,1010 (Fed. Cir. 1987) citing *In re Qwik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). See also *In re Abcore Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. Here, neither the word “WORLD” as used in the mark, nor the “DVD WORLD” mark as a whole is merely descriptive of Applicant’s services.

A. Opposer’s evidence.

Opposer’s evidence of descriptiveness consists primarily of a list of domain names that contain the words “DVD” and “WORLD” (hereafter, the “Domain List”). The value of this evidence is minimal at best because Opposer has not provided any evidence showing what, if anything , appears at the listed domains. Opposer’s statements such as “Given the widespread use of DVD WORLD by countless others for the same or similar goods and services” are disingenuous and unsupported. Opp. Brief at p. 12. Opposer has not, on the record, demonstrated that a single entity other than Applicant has used DVD WORLD in any commercial manner.

Opposer has not even demonstrated that she, Ms. Dhaliwal, has used DVD WORLD in any commercial manner or has any real plans to do so.

The mere existence of the domain names on Opposer's Domain List does not demonstrate that they are used in connection with the relevant services, that they are used at all, or that they are used in the United States. The Domain List is unreliable and unpersuasive evidence of the alleged descriptiveness of Applicant's DVD WORLD mark. For example, some of the domain names on the Domain List are owned by Applicant or its principal,⁷ and some of the domain names contain foreign country top level domains, such as .ca and .uk.

16	Q	To your knowledge, does registration of a
17		domain name mean that the domain name is being used
18		in any way?
19	A	No.
20	Q	To your knowledge, just briefly reviewing
21		the 206 records on here, are there some that belong
22		to you?
23	A	Yes.
24	Q	And just reviewing the 206 domain names
25		here, are there numerous ones which have country
1		codes at the end of them?
2	A	Yes.
3	Q	Country codes other than -- that are
4		outside of the U.S.?
5	A	Yes.

Papetti Dep. 94:20-95:5.

Opposer Dhaliwal has not offered any evidence of any actual use, promotion, or commerce related to any of the domain names on the Domain List. Lahoti admits that he did not examine the web pages that appear at each domain name, and that he does not remember much of what he saw at the sites he did visit. Lahoti Dep. 35:24-36:4. For example, of the 106 domain names offered by Opposer as evidence of descriptiveness, Mr. Lahoti alleges that he saw only a

⁷ Applicant owns approximately 107 domain names containing "DVD" and "WORLD." Papetti Dep. 89:14-17.

few selling DVDs, “I *think I must have* encountered at least half a dozen, and then *maybe* I just *pretty much* stopped there and thought, well, that’s *pretty much* – I don’t – you know, I was *pretty convinced* it was a lot. So I *must have* encountered *about* half a dozen, at least.” Lahoti Dep. at 8:14 – 8:18 (emphasis added). As a whole, the Domain List should be afforded negligible weight, if any, as it does not establish any facts regarding ownership or use of domain names in the United States by third parties. Even if it did, mere ownership of domain names by others has no bearing on the issue before the Board, namely the alleged descriptiveness of Applicant’s mark.

B. Applicant’s DVD WORLD mark is not descriptive.

Applicant’s mark is the standard character wording “DVD WORLD” for use in connection with “Online Retail store services and distributorships of DVD movies” in Class 35 and “Motion Picture Production and Distribution” in Class 41. See Notice of Opposition and application record. Applicant does not dispute that “DVD” is descriptive, and the term “DVD” has been disclaimed apart from use in the mark.⁸ Opposer’s argument focuses on an analysis of the term “WORLD.” However Opposer Dhaliwal has failed to show by a preponderance of the evidence that the “DVD WORLD” mark as a whole is merely descriptive. “DVD WORLD” is at most suggestive because it has multiple meanings related to Applicant’s services and is used without disclaimer in many comparable third party registrations.

The Board must consider whether the mark as a whole is descriptive. A mark is not necessarily descriptive even if there is some sense in which each word in the mark may be considered descriptive. *See No Nonsense Fashions, Inc. v. Consolidated Foods Corp*, 226 USPQ 502 (TTAB 1985) (holding that respondent’s SHEER ELEGANCE mark is not descriptive as a whole even though respondent admitted that the word SHEER and ELEGANCE may each be

⁸ See Applicant’s Response to Office Action, submitted May 11, 2005.

used descriptively in relation to pantyhose). In an opposition, it is the Opposer's burden to prove descriptiveness by a preponderance of the evidence. Opposer here has fallen well short of its burden to show that the phrase DVD WORLD as a whole is descriptive.

Applicant's DVD WORLD mark as a whole is not descriptive because it is not clear what the word "WORLD" means or modifies in the mark as a whole. Furthermore, Opposer has not introduced any evidence of third party use of "WORLD" or "DVD WORLD" in a descriptive manner.

i. Meaning of "WORLD" in the context of Applicant's mark and services.

The term "WORLD," applied to Applicant's services, is suggestive of a service or store that features a wide breadth of information or materials. Generally, when the term "WORLD" follows a word descriptive of the subject matter, "WORLD" means "a distinctive class of persons or their sphere of interest," and/or "the sphere or scene of one's life and action."⁹ While "WORLD" has other definitions, they are not as relevant given the context of Applicant's services and its use following a descriptive term.¹⁰ The same suggestive meaning is contained in the dozens of third party registrations cited in the table below.

⁹ See Attachment A: Merriam Webster's Online Dictionary (2010) "world" (www.merriam-webster.com/dictionary/world)(accessed and printed August 11, 2010) and Applicant requests that the Board take judicial notice of the definition of "world." *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, fn 5 (TTAB 1999) ("The board may take judicial notice of a fact which is 'not subject to reasonable dispute in that it is... capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned'"). Judicial notice may be taken at any stage of a Board proceeding. *Id*




¹⁰ For a discussion by the Board of the meaning of "WORLD" in the context of its strength in an analysis of whether RETREIVER WORLD and RETREIVER are likely to be confused, see *In re Diane B. Coffey*, Ex Parte Appeal of Serial No. 76000318 (TTAB 2002)(non-precedential)(finding no likelihood of confusion)("considering applicant's mark RETREIVER WORLD in its entirety as applied to applicant's services, we find that the mark connotes retriever sporting dogs and the sphere of interest and activities pertaining to or shared by such dogs and their owners").

ii. *Third party registrations in Class 41 containing disclaimed descriptive term(s) plus un-disclaimed “WORLD.”*

Registrations for marks with analogous uses of the term ‘WORLD’ obtained from the records of the USPTO make it clear that Applicant’s DVD WORLD mark is not descriptive. Rather, Applicant’s DVD WORLD mark is suggestive of the sphere of activities, goods, and services of the descriptive term “WORLD” follows. The trademark registry contains many current registrations for marks consisting of WORLD paired with a descriptive term. These trademarks registered on the Principal Register of the USPTO contain a disclaimed term followed by “WORLD,” without any disclaimer or claim of acquired distinctiveness regarding “WORLD.” Table 1, *below*, displays a list of analogous uses of ‘WORLD’ in use-based trademark registrations. Applicant entered these registrations into the evidentiary record as Exhibit 3 attached to Applicant’s First Notice of Reliance.



Table 1: Third Party Trademark Registrations
Pairing Disclaimed Term(s) with the Undisclaimed term ‘WORLD’

Reg. No.	Mark	Disclaimer	Goods & Services
3200757	STAFFING WORLD	STAFFING	Arranging and conducting conventions and expositions in the field of employment, human resources, legal, managerial, financial, strategic, and operational issues as they pertain to the staffing industry. Educational services, namely, conducting seminars and workshops in the field of employment, human resources, legal, managerial, financial, strategic, and operational issues related to the staffing industry.
3360862	Bikini World	BIKINI	Provision of non-downloadable on-going audio visual film and television programs via video on demand, television broadcast, cable television, broadband, internet and mobile device services.



Reg. No.	Mark	Disclaimer	Goods & Services
3250665	GOALKEEPER WORLD	GOALKEEPER	Pre-recorded CDs and DVDs featuring instructional soccer goaltending performance development programs. Educational services, namely, conducting instructional seminars and soccer camps for training goaltenders.
3143467	Wild West World	WILD WEST	Entertainment and educational services- namely an amusement park with rides, live performances and exhibits with a focus on western United States heritage.
2992295	Brides World	BRIDES	Arranging and conducting trade show exhibitions in the field of weddings; Arranging and conducting trade shows in the field of weddings; Conducting trade shows in the field of weddings; Arranging and conducting trade shows in the field of tuxedos; Mailing list preparation; Organizing exhibitions for bridal shows; promoting and conducting trade shows in the field of weddings. Entertainment in the nature of fashion shows; Organizing exhibitions for bridal shows.
2959770		ULTRASOUND	Educational services, namely, conferences in the field of ultrasound technology.
2959551		FAST PITCH	Training services in the field of baseball.
3056291	WOMEN'S WORKOUT WORLD	WOMEN'S WORKOUT	Clothing, namely, sweatpants, skirts, shirts, coats, shorts, and headwear. Health club services, namely, providing instruction and equipment in the field of physical exercise; providing classes in physical fitness, exercise, and weight control and related individual consulting services on physical fitness and exercise; arranging and conducting athletic competitions; arranging and conducting conferences, seminars, workshops on health and fitness programs.
2966337		SHOTGUN	Providing information on-line relating to shotguns and their use.

Reg. No.	Mark	Disclaimer	Goods & Services
3451843	Air Cargo World	AIR CARGO	PROVIDING NEWS AND INFORMATION IN THE FIELDS OF AIR CARGO TRAFFIC INDUSTRIES VIA THE INTERNET. VOCATIONAL GUIDANCE IN THE FIELD OF THE IMPORT/EXPORT INDUSTRY VIA THE INTERNET.
3128418	SLIMMING WORLD	SLIMMING	Printed matter, namely printed guides, diaries, leaflets, pamphlets, books, booklets, printed tables, printed schedules, printed cards all for the use in the areas of, or relating to, slimming, weight control, diet, dieting, exercise and health; directories, pamphlets and charts, all for use in the areas of, or relating to, slimming, weight control, diet, dieting, exercise and health; recipe books, recipe cards, recipe leaflets, recipe booklets; publications in the nature of books, magazines, diaries, brochures, leaflets, pamphlets, directories, guides and booklets in the areas of, or relating to, slimming, weight control, diet, dieting, exercise and health. Providing training in the fields of slimming, weight control, diet, dieting, exercise and health; arranging and conducting of educational seminars; education and training in the nature of arranging and conducting educational seminars and classes relating to slimming, weight control, diet, dieting, exercise and health and the dissemination of educational publications, videos, DVDs, and tutorials for use in connection therewith; advisory and counseling relating to physical exercise. Healthcare advisory and counseling services relating to slimming, diet, dieting, weight control and healthcare

Reg. No.	Mark	Disclaimer	Goods & Services
2823394	GENTLEMEN'S WORLD	GENTLEMEN'S	Electronic publication of magazines, books, brochures, and journals and providing publishing services, namely, publication of text and graphic works of others both in printed form and non-downloadable electronic form such as CD, DVD, video, software, on-line via a global computer network, the Internet and/or electronic mail for commercial purposes in the fields of style, fashion, music, dances, health, sport, film, food and drink, sex, cars, yachts, collectibles, beauty, and alternative life-styles.
3594020	VIRTUAL WORLD	VIRTUAL	Amusement center services.
3595988	Media World	MEDIA	Television broadcasting services. Entertainment services, namely, production of television shows; entertainment in the nature of on-going television programs in the fields of news, comedy, variety, sports and public service programs, and providing information in the field of entertainment and education via a global computer network.
3548920	CONCERT WORLD	CONCERT	Clothing, namely, hats and t-shirts. Providing news, information, education in the nature of lectures, and analysis of sporting events, musical and other entertainment events via an internet website; arranging for ticket reservations for sporting events, musical and other entertainment events; ticket agency services for sporting events, musical and other entertainment events, rendered online, through phone orders and through ticket outlets.
3543115	STILT WORLD	STILT	Entertainment in the nature of dance, circus, and acrobatic performances.
3474597	BLACK BELT WORLD	BLACK BELT	Training services in the field of martial arts; Educational services, namely, providing programs, classes, workshops, seminars, summer camps and private lessons in the field of martial arts, self-defense and tae kwon-do; providing a website featuring martial arts and tae kwon-do information.
3449296	TUBE WORLD	TUBE	Providing facilities for snow tubing.

Reg. No.	Mark	Disclaimer	Goods & Services
3432304	SAFETY WORLD	SAFETY	Printed instructional material for employers and employees in the field of workplace safety. Educational services, namely, providing training classes to employers and employees in the field of workplace safety, and distributing course materials in connection therewith. Consulting and advisory services in the field of workplace safety; safety inspection audits.
3380493		WORK OUT	Health club services, namely, providing instruction and equipment in the field of physical exercise; providing fitness and exercise facilities; providing physical fitness conditioning classes; providing physical fitness instruction; personal training services, namely, strength and conditioning services.
3340453	WORD WORLD	WORD	Web site featuring information about a children's animated television series.
3134786	TAEKWONDO WORLD	TAEKWONDO	Martial arts and yoga training services.
3069984	Country World	COUNTRY	Television Show Production.
2841013		PERSONAL TRAINERS	PHYSICAL FITNESS INSTRUCTION.
2459685	HOMESCHOOL WORLD	HOMESCHOOL	Providing a website featuring information about homeschooling.
2629816	INVESTOR'S WORLD	INVESTOR'S	Financial newsletters. Providing on-line information relating to finance and investing. On-line publication of newsletters relating to finance and investing.
2393448	EDUCATION WORLD	EDUCATION	Advertising and business services for others promoting the education-related goods and services of others by preparing and placing advertisements that are accessible at a site on a global computer network. Educational services, namely maintaining a site on a global computer network at which databases of academic information are accessible for study and research.

Reg. No.	Mark	Disclaimer	Goods & Services
2538543	DIGITAL MUSIC WORLD	DIGITAL MUSIC	Computerized on-line retail services in the field of computer software for games and music. Entertainment in the nature of contests in the field of music and computer services, namely, providing online information services in the field of music.
2497873	SEXY WORLD		ENTERTAINMENT IN THE NATURE OF AN ON-GOING TELEVISION PROGRAM IN THE FIELD OF ADULT ENTERTAINMENT; PRODUCTION AND DISTRIBUTION OF ADULT ENTERTAINMENT MOTION PICTURES.
2491912	NEW YORK ART WORLD	NEW YORK ART	ONLINE RETAIL AND AUCTION SERVICES IN THE FIELD OF ARTWORKS ALL RENDERED BY MEANS OF A GLOBAL COMPUTER INFORMATION NETWORK. PROVIDING INFORMATION RELATING TO CULTURAL EVENTS RELATED TO NEW YORK ARTISTS BY MEANS OF A GLOBAL COMPUTER NETWORK. COMPUTER SERVICES, NAMELY, PROVIDING ON-LINE MAGAZINES IN THE FIELD OF ART AND NEW YORK ARTISTS BY MEANS OF A GLOBAL COMPUTER INFORMATION NETWORK.
2357472	MARINE WORLD	MARINE	ENTERTAINMENT IN THE NATURE OF AMUSEMENT PARKS, THEME PARKS, WILDLIFE PARKS AND OCEANARIUMS; ENTERTAINMENT IN THE NATURE OF LIVE PERFORMANCES, NAMELY, LIVE ANIMAL PERFORMANCES AND THEATRICAL PERFORMANCES.
2443152	EARTH SCIENCE WORLD	EARTH SCIENCE	MAINTAINING DATABASES VIA A WEBSITE ACCESSIBLE THROUGH A GLOBAL COMPUTER NETWORK WHICH FEATURES EDUCATIONAL, INSTRUCTIONAL AND BIBLIOGRAPHIC CONTENT FOR STUDENTS AND THE GENERAL PUBLIC IN THE FIELD OF EARTH SCIENCE.

Reg. No.	Mark	Disclaimer	Goods & Services
2646019	YOGA WORLD	YOGA	Education and training services in the field of personal fitness, namely, aerobics, personal training, yoga and cardiovascular training; physical fitness instruction; health clubs; yoga studios.
2019252		HEALTH	Children's health museum.
2359093	WILD OUTDOOR WORLD	OUTDOOR	INSTRUCTIONAL AND TEACHING MATERIALS, NAMELY, TEACHERS' GUIDES, INFORMATIONAL PAMPHLETS, POSTERS, STICKERS, CALENDARS, MAGAZINES, AND NEWSPAPERS, ALL DIRECTED TO EDUCATING CHILDREN ABOUT WILDLIFE AND HABITAT PRESERVATION. PUBLISHING STATE-SPECIFIED INSTRUCTIONAL AND TEACHING MATERIALS, NAMELY, TEACHERS' GUIDES, INFORMATIONAL PAMPHLETS, MAGAZINES, AND NEWSPAPERS, ABOUT WILDLIFE AND HABITAT PRESERVATION FOR USE IN EDUCATING CHILDREN.
2170821		BASKETBALL	Mail order catalog services featuring basketball books, videos and equipment. Conducting basketball camps, basketball clinics, publication of basketball books and production of basketball videos.
2076916	ICE WORLD	ICE	Entertainment services, namely, operating an ice skating rink.
2030655	OUTDOOR WORLD	OUTDOOR	Entertainment services, namely, on-going hunting, fishing and camping television programs.
1889463	TENNIS WORLD	TENNIS	Entertainment in the nature of ongoing television programs in the field of tennis.
2253856	CASINO WORLD	CASINO	Dockside casino services.
1708820	FAMILY WORLD	FAMILY	Educational services; namely, conducting courses in the field of successful personal relationships and family living.

Reg. No.	Mark	Disclaimer	Goods & Services
1401636	HERSHEY'S CHOCOLATE WORLD	CHOCOLATE	ENTERTAINMENT SERVICES- NAMELY, PROVIDING AND OPERATING A FACILITY EXHIBITING THE HISTORY AND HIGHLIGHTS OF THE CHOCOLATE INDUSTRY.
1627506	MEETING WORLD	MEETING	CONDUCTING TRADE SHOWS AND EXHIBITIONS IN THE FIELD OF ORGANIZING BUSINESS CONFERENCES. CONDUCTING CONFERENCES, SEMINARS AND WORKSHOPS IN THE FIELD OF ORGANIZING BUSINESS CONFERENCES.
1642976	CORPORATE TRAVEL WORLD	CORPORATE TRAVEL	CONDUCTING TRADE SHOWS AND EXHIBITIONS IN THE FIELD OF BUSINESS TRAVEL. CONDUCTING CONFERENCES, SEMINARS AND WORKSHOPS IN THE FIELD OF BUSINESS TRAVEL.
1627505	MULTI-HOUSING WORLD	MULTI-HOUSING	CONDUCTING TRADE SHOWS AND EXHIBITIONS IN THE FIELD OF MULTI-HOUSING REAL ESTATE. CONDUCTING CONFERENCES, SEMINARS AND WORKSHOPS IN THE FIELD OF MULTI-HOUSING REAL ESTATE.

iii. Applicant is owner of a prior registration for related services of a logo containing “DVD WORLD” without disclaimer of “WORLD.”

Additionally, Applicant is the owner of U.S. Trademark Registration No. 2,912,970 for the image below containing the wording DVD WORLD for use with “Online Retailing Of DVDs.”



See Applicant's First Notice of Reliance, Exhibit 4. Applicant's prior registration also contains a disclaimer of "DVD" and no disclaimer of "WORLD." This prior registration is further evidence that "WORLD" is not descriptive as applied to Applicant's services.

C. Descriptiveness Conclusion

If, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 588 F.2d 811 (CCPA 1978); *In re Atavio*, 25 USPQ 1361 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt must be resolved in applicant's favor. *In re Atavio* at 1363.

Even if Opposer had successfully demonstrated that the phrase DVD WORLD is descriptive, Opposer has not demonstrated that the mark has not acquired distinctiveness. The record makes clear that Applicant sells thousands of DVDs per year through its website (Papetti Dep. 31:4-9) and that related companies have used the DVD WORLD mark in commerce for the relevant services since at least 1998. Furthermore, Applicant is the owner of Registration No. 2,912,970 for DVD WORLD & Design for use in connection with "Online Retailing Of DVDs." See Papetti Dep 83:14-16 and 99:5-12; Applicant's First Notice of Reliance, Exhibit 4.

III. Opposer has not proven that Applicant has failed to use its DVD WORLD mark as a trademark for any of the services in the application.

Opposer's Trial Brief argues that "...Applicant itself has failed to use the mark as a trademark indicative of source" and "...has not used the DVD WORLD mark as a trademark to designate its goods and services as products of DVD World Picture Corporation." Opposer's

Brief p. 13.¹¹ However, the evidence shows that Applicant DVD World Picture Corporation has used the DVD WORLD mark, both itself and through expressly authorized related entities, in connection with each of the goods and services identified in the application.

Applicant seeks registration of DVD WORLD for use in connection with two categories of services: (1) “Online Retail store services and distributorships of DVD movies” in class 35 (hereafter, “DVD Sales”), and (2) “Motion Picture Production and Distribution” in class 41 (hereafter, “Production Services”). *See* Application record. Of these two categories of services, Opposer’s Brief alleges only that “DVD World Pictures Corp. does not sell DVDs online.” Opp. Brief p. 1.¹² Opposer concedes that one or more of Papetti’s other entities under The DVD World Company offers DVD Sales. *See*, e.g., Opp. Brief p. 3 (“Instead, Papetti sells DVDs through The DVD World Company, a sole proprietorship (not a corporation).”)¹³ Opposer’s Brief also concedes that Applicant DVD World Pictures Corp. is owned by Edwin Papetti and Edwin Papetti is also the sole proprietor of The DVD World Company, through which Papetti owns and operates “many other entities” or divisions” offering services. Opp. Brief p. 14. Opposer’s Brief also states that “[Applicant] is also involved in live event recording and DVD creation” (Opp. Brief p. 3), and it relies upon, without rebuttal, Papetti’s testimony that Applicant itself offers “video production and reproduction,” “Motion picture production and

¹¹ This issue appears to have been alleged by Opposer as its Third Cause for Opposition in its Notice of Opposition. *See* Notice of Opposition, ¶¶10-15.

¹² *See also*, Opp. Brief, p. 3 (“However, DVD World Pictures Corp. does not sell DVDs online”; Opp. Brief, p. 16 (“In short, the DVD WORLD mark is not used to identify any goods of the Applicant, DVD World Pictures Corp., because DVD World Pictures Corp. does not sell the DVDs”).

¹³ Likewise, Opposer argues that “...substantially all of [Applicant’s] business under the DVD WORLD mark for online retail distribution of DVD movies in International Class 35 takes place at the website www.dvdworldonline.com”, a website allegedly owned by The DVD World Company rather than Applicant DVD World Pictures Corp. *See* Opp. Brief p. 14-15

distribution” and “motion picture studios.” Opp. Brief p. 18 citing Papetti Dep. 50:10-51:6.¹⁴

Therefore, in the absence of any statement in Opposer’s Brief to the contrary, Applicant considers this a concession that Applicant offers Production Services.¹⁵

With respect to Opposer’s allegation of non-use, the only question before the Board is whether Applicant DVD World Picture Corp. offers DVD Sales under the DVD WORLD mark. The evidence of record shows that Applicant does offer DVD Sales under the DVD WORLD mark through both (a) its retail sales of its own motion picture productions on DVD, and (b) the authorized retail sale of commercial titles on DVDs through Applicant’s related entities.

A. Applicant’s DVD Sales of its own motion picture productions

In addition to the commercially available movie titles available for sale through the DVDDestination.com and DVDWorldOnline.com websites, Applicant’s owner has testified that Applicant DVD World Pictures Corp. also offers retail DVD sales of Applicant’s own motion picture productions:

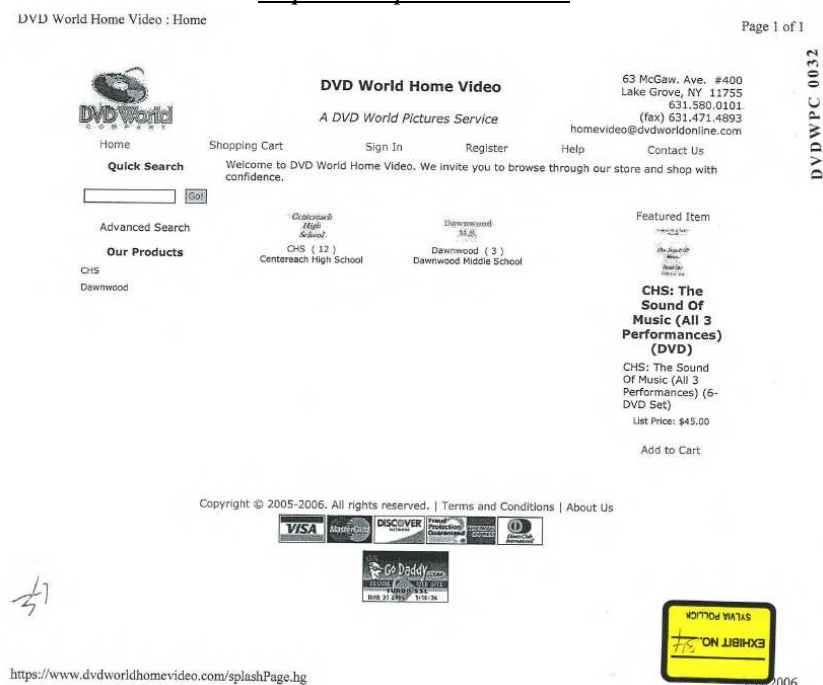
14	Q	But, to be clear, the services offered with
15		respect to the sale of DVD's are not services that
16		are offered by DVD World Pictures Corporation on
17		either the DVDDestination.Com website or the
18		DVDWorldOnline.Com website; correct?
19	MR. PELTON:	I'll object as asked and
20		answered previously, I believe, but....
21	THE WITNESS:	As stated before, DVD
22		World Pictures covers the retail and distribution
23		of titles that we record, edit, and produce.
24		The titles handled by DVDDestination.Com,
25		DVDWorldOnline.Com, and HDDVDWorld.Com would be
62		
1		held under the DVD World Company, which is also
2		the parent company of DVD World Pictures Corp.

¹⁴ Applicant notes that the selection of the cited Papetti Dep. 50:10-51:6 reproduced in Opposer’s Brief at p. 18 omits lines 50:23-51:2, resulting in a narrower range of Applicant’s services than was actually stated in the full testimony.

¹⁵ See also PROCEDURAL EXCLUSIONS, part a, p. 14, *supra*.

Papetti Dep. 62:14-63:2. Furthermore, Mr. Papetti's testimony is supported by unrebutted documentary evidence. For example, Papetti Dep. Exhibit 34, *shown below*, is an image of the web page at www.dvdworldhomevideo.com where Applicant offers DVDs of its own productions for sale to the public. The exhibit shows three different high school and middle school productions available for purchase online, at least one of which is available in DVD format. *Id.* Mr. Papetti's testimony also confirmed that "this particular website would sell the live event DVD's." Papetti Dep. 57:13-18, Exhibit 34. In addition, this web page uses the DVD WORLD mark as an indicator of source in several places, including the DVD WORLD design mark in the top left, the center title ("DVD World Home Video"), and in the welcome message – "Welcome to DVD World Home Video. We invite you to browse through our store and shop with confidence." Papetti Dep. Exhibit 34. Furthermore, the subtitle at the top center of the exhibit identifies the website as "A DVD World Pictures Service." *Id.*

Papetti Dep. Exhibit 34:



Opposer has not rebutted this testimony and evidence showing that Applicant, DVD World Pictures Corp., offers online retail store services and distributorships of DVD movies under the DVD WORLD mark. Instead, Opposer attempts to support its allegation of non-use with selections from Mr. Papetti's testimony regarding the sale of commercially available titles, rather than those produced by Applicant itself. For example, the following two sections of Opposer's brief attempt to construe Papetti's testimony regarding sales of commercially available titles as an admission that Applicant does not offer retail sales at all.

Papetti goes on to explain that, in fact, none of the sales that occur via www.dvdworldonline.com are actually sold through Applicant, DVD World Pictures Corp.:

Q Was it ever a purpose of DVD World Pictures Corporation to sell commercially available movies?
A No, because that's handled by HD DVD World.

...

Q Do any sales of DVD's that are sold on the website that I can access through DVDWorldOnline.Com – are any of those DVD sales sold through DVD World Pictures Corporation: yes or no?
A The DVD's are available through DVDWorldOnline.Com or HDDVDWorld.Com are commercially available titles. They are not created by DVD World Pictures.
Q **And none of the sales that occur on DVDWorldOnline.Com or HDDVDWorld.Com go through DVD World Pictures Corporation; correct?**
A **That's correct.**

See Papetti Testimony at 33:20 – 35:20 (emphasis added). In short, the DVD WORLD mark is not used to identify any goods of the Applicant, DVD World Pictures Corp., because DVD World Pictures Corp. does not sell the DVDs.

Opposer's Brief p. 15, 16.

Apart from misrepresenting the testimony of Applicant's owner, Opposer has not offered anything to support its allegation that Applicant has not offered the services identified in the application at issue in this proceeding. Therefore, Opposer's burden of proof has not been met.

B. Applicant's DVD Sales through authorized related entities

In addition to Applicant's retail sales of its own productions on DVD, Applicant DVD

Wolrd Pictures Corp. has also authorized other related entities owned by Applicant's principal Edwin Papetti to sell third-party commercial DVDs under the DVD WORLD mark.

Trademark Act § 5, in pertinent part, provides that “[w]here a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.” Trademark Act § 45 in turn defines “related company” as meaning “any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.”

According to TMEP §1201.03, “The essence of related-company use is the control exercised over the nature and quality of the goods or services on or in connection with which the mark is used. When a mark is used by a related company, use of the mark inures to the benefit of the party who controls the nature and quality of the goods or services. This party is the owner of the mark and, therefore, is the only party that may apply to register the mark. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Here, Mr. Papetti's unrebutted testimony states that Applicant DVD World Picture Corp is owned by him under his parent sole proprietorship The DVD World Company. *See* Papetti Dep. 16:16-23; 50:18-51:6; 61:21-62:13. In addition, Applicant's contract with the Centereach High School Drama Department clearly identifies DVD World Pictures Corp. as a “division of The DVD World Company.” *See* Papetti Dep. Exhibit 27. Likewise, the website listing all of the divisions of The DVD World Company describes Applicant as “the only corporate division of The DVD WORLD Company.” *See* Papetti Dep. Exhibit 32. Furthermore, thy web page shown in Papetti Dep. Exhibit 31, as well as many others entered into evidence by Opposer,

contains a trademark notice referencing DVD World Pictures Corp. and The DVD World Company:

“The “DVD World” Name and Design Are Either Registered Trademarks or Trademarks of DVD World Pictures Corp., A Division of The DVD World Company. Any use of the DVD World name or design without the permission of The DVD World Company is strictly prohibited.”

See Papetti Dep. Exhibit 31; see also Papetti Dep. Exhibits 30, 32 and 35.

Opposer’s brief concedes that Applicant DVD World Pictures Corp. is owned by Edwin Papetti. Opp. Brief p. 14. Opposer also concedes that Edwin Papetti is also the sole proprietor of The DVD World Company, through which Papetti owns and operates “many other entities” or “divisions” offering a variety of services. *Id.* This un rebutted testimony and evidence shows that Papetti’s other entities under The DVD World Company which have used the DVD WORLD mark have done so as related entities, under unity of control and ownership, and with the express authorization of Applicant.

In conclusion, Applicant itself and through related companies has clearly used the DVD WORLD mark on all of the services identified in the application. As a result, Opposer’s has not met her burden of proof by a preponderance of the evidence, and Opposer’s claim must be dismissed.

CONCLUSION

Opposer Dhaliwal has failed to prove any personal stake in the proceeding and has failed to demonstrate standing to oppose the application for “DVD WORLD.” Furthermore, the term “WORLD” is not descriptive as used in Applicant’s mark and the mark as a whole is suggestive. In addition, the evidence presented by Opposer fails to demonstrate – by a preponderance of evidence - that Applicant’s mark is descriptive. Opposer’s claim that Applicant has not used its DVD WORLD mark in connection with each of the services in the application is contrary to the

evidence of record. Finally, issues which Opposer has pleaded but not briefed or briefed but not properly pleaded must be dismissed.

Wherefore, Applicant respectfully requests the Board find that: Opposer Dhaliwal has not demonstrated standing to oppose Applicant's marks. Even if Opposer Dhaliwal does have standing, she has failed to demonstrate by a preponderance of the evidence that Applicant's DVD WORLD mark is descriptive of Applicant's services or that Applicant has failed to use its mark in connection with the applied-for services. Even if Opposer had successfully demonstrated that the phrase DVD WORLD is descriptive, Applicant's mark has clearly acquired distinctiveness based on more than ten years use in commerce and Applicant's registration, more than five years ago, of a logo containing the identical wording for related services without a disclaimer of "WORLD."

Wherefore, Applicant respectfully requests the Board dismiss the Opposition and allow registration of the mark in Application Serial No. 78/495,856.

Dated this 12th day of August, 2010.

Respectfully Submitted,
DVD WORLD Pictures Corp.,




By: _____
Erik M. Pelton

ERIK M. PELTON & ASSOCIATES, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089
EMAIL: uspto@tm4smallbiz.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of APPLICANT'S TRIAL BRIEF was deposited as First Class mail with the United States Postal Service on August 12, 2010, to Counsel for Opposer at the following address:

R. JOSEPH TROJAN
TROJAN LAW OFFICES
9250 WILSHIRE BLVD SUITE 325
BEVERLY HILLS, CA 90212

By: 

Erik M. Pelton, Esq.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MS. ANITA DHALIWAL
Opposer,

v.

DVD WORLD Pictures Corp.,
Applicant.

Opposition No. 91167207

Application Serial No. 78495856


Mark:

DVD World

APPLICANT'S TRIAL BRIEF

Attachment A:

“world,” Merriam Webster’s Online Dictionary (2010)



Home
Premium Services
Downloads
Word of the Day
Word Games
Open Dictionary
Spelling Bee Hive
Online Store
Help
About Us


o Visit: Unabridged Visual Britannica Online Encyclopedia ESL: Learner's **NEW** for Kids: Word Central


☒ Dictionary
 ☐ Thesaurus
 ☐ Spanish/English
 ☐ Medical

world

Entries 1 to 10 of 30. [Next 10](#)

- [1 world \(noun\)](#)
- [2 world \(adjective\)](#)
- [world beat \(noun\)](#)
- [world-beater \(noun\)](#)

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Main Entry: **¹world** 

Pronunciation: \ˈwɜr(-ə)ld\

Function: *noun*

Etymology: Middle English, from Old English *woruld* human existence, this world, age (akin to Old High German *weralt* age, world); akin to Old English *wer* man, *eald* old — more at [VIRILE](#), [OLD](#)

Date: before 12th century

1 a : the earthly state of human existence **b** : life after death —used with a qualifier <the next world>

2 : the earth with its inhabitants and all things upon it

3 : individual course of life : [CAREER](#)

4 : the inhabitants of the earth : the human race

5 a : the concerns of the earth and its affairs as distinguished from heaven and the life to come **b** : secular affairs

6 : the system of created things : [UNIVERSE](#)

7 a : a division or generation of the inhabitants of the earth distinguished by living together at the same place or at the same time <the medieval world> **b** : a distinctive class of persons or their sphere of interest or activity <the academic world> <the digital world>

8 : human society <withdraw from the world>

9 : a part or section of the earth that is a separate independent unit

10 : the sphere or scene of one's life and action <living in your own little world>

11 : an indefinite multitude or a great quantity or distance <makes a world of difference> <a world away>

12 : the whole body of living persons : [PUBLIC](#) <announced their discovery to the world>

13 : [KINGDOM](#) 5 <the animal world>


14 : a celestial body (as a planet)

— **for all the world** : in every way : [EXACTLY](#) <copies which look for all the world like the original>

— **in the world** : among innumerable possibilities : [EVER](#) —used as an intensive <what in the world is it>














— **out of this world** : of extraordinary excellence : [SUPERB](#)

Where Did The
"Green-Eyed Monster"
Come From?



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MS. ANITA DHALIWAL
Opposer,

v.

DVD WORLD Pictures Corp.,
Applicant.

Opposition No. 91167207

Application Serial No. 78495856

Mark:

DVD World

APPLICANT'S TRIAL BRIEF

Attachment B:

April 3, 2002 Opinion from *In re Diane B. Coffey*,

Ex Parte Appeal of Serial No. 76000318 (TTAB 2002)

(non-precedential)

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

03 APR 2002

Paper No. 9
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diane B. Coffey

Serial No. 76/000,318

Taylor M. Davenport of Coats and Bennett, P.L.L.C. for
Diane B. Coffey.

Christopher L. Buongiorno, Trademark Examining Attorney,
Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Cissel, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark RETRIEVER WORLD (in typed form; RETRIEVER has
been disclaimed) for "computerized on-line ordering
services, catalog services, and retail store services
featuring sporting goods, namely, hunting, fishing, and
animal training equipment," in Class 35.¹

¹ Serial No. 76/000,318, filed March 14, 2000. The application
is based on use in commerce under Trademark Act Section 1(a), and
"1998" is alleged as the date of first use and date of first use
in commerce. The application also covers Class 42 services

The Trademark Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark is confusingly similar to the mark RETRIEVER, previously registered on the Principal Register for "bowfishing reels."² When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have filed appeal briefs, but no oral hearing was requested. We reverse the refusal to register.

Initially, we sustain the Trademark Examining Attorney's objection to the evidentiary materials applicant submitted with her appeal brief. Those materials (which purport to demonstrate the existence of third-party registrations and Internet usage of marks which include the word RETRIEVER) are untimely under Trademark Rule 2.142(d), and we have given them no consideration. Likewise, we have given no consideration to the mere listing of third-party

recited as "computer services, namely, designing and implementing network web pages for others; hosting the web sites of others on a computer server for a global computer network." Registration was not refused as to these Class 42 services, and they are not involved in this appeal.

² Registration No. 2,253,559, issued June 15, 1999. The Trademark Examining Attorney initially issued a second Section 2(d) refusal based on Supplemental Register Registration No. 2,064,230, which is of the mark RETRIEVER TRAINER for "remote control devices for training retrievers, namely, electronic transmitters and receivers." The Trademark Examining Attorney withdrew this second refusal in his final office action.

registrations and applications (involving marks which include RETRIEVER) that applicant set forth in her response to the first office action. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974).

The evidence of record includes: (1) the Trademark Examining Attorney's submission of the following dictionary definition of "retriever": "one that retrieves; esp : a dog of any of several breeds (as a golden retriever) having a heavy water-resistant coat and used esp. for retrieving game"; (2) the Trademark Examining Attorney's submission of the following dictionary definition of "world":

1 a : the earthly state of human existence **b** : life after death - used with a qualifier <the next ~> **2** : the earth with its inhabitants and all things upon it **3** : individual course of life : CAREER **4** : the inhabitants of the earth : the human race **5 a** : the concerns of the earth and its affairs as distinguished from heaven and the life to come **b** : secular affairs **6** : the system of created things : UNIVERSE **7 a** : a division of or generation of the inhabitants of the earth distinguished by living together at the same place or at the same time <the medieval ~> **b** : a distinctive class of persons or their sphere of interest <the academic ~> **8** : human society <withdraw from the ~> **9** : a part or section of the earth that is a separate independent unit **10** : the sphere or scene of one's life and action

<living in your own little ~> **11** : an
indefinite multitude or a great quantity or
distance <makes a ~ of difference> <a ~ away>
12 : the whole body of living persons : PUBLIC
<announced their discovery to the ~> **13** :
KINGDOM 5 <the animal ~> **14** : a celestial body
(as a planet);

(3) the Trademark Examining Attorney's submission of
printouts of four third-party use-based registrations which
cover both Class 28 fishing equipment and Class 35 services
in the field of fishing equipment;³ and a printout of the
above-referenced third-party Supplemental Register

³ Reg. No. 1,932,748, of the mark CAPT. HARRY'S for "fishing supplies, namely rods and lures" and "retail stores featuring fishing supplies, retail outlets featuring fishing supplies, retail shops featuring fishing supplies, wholesale stores featuring fishing supplies, and mail order catalog services featuring fishing supplies"; Reg. No. 2,012,035, of the mark NYMPH MASTER for, inter alia, "hand held fishing nets for sportsmen, fishing fly boxes, fishing flies and tackle boxes" and "mail order catalog services featuring fishing related goods"; Reg. No. 2,306,481, of the mark CENTERLINE for "fishing equipment, namely, fish attractant scents, feeder tubes for bait, and fishing hook removers" and "mail order and mail order catalog services featuring fishing equipment and instructional fishing videos; wholesale distributorship services featuring fishing equipment and instructional fishing videos; computerized on-line retail services in the field of fishing equipment and instructional fishing videos"; and Reg. No. 2,346,450, of the mark THE SURFCASTER for "fishing equipment, namely, fishing rods, fishing lures, fishing reels, fishing rod holders, fishing reel bags, fishing gear bags, fly fishing stripping baskets, fly lines, gaffs, gaff holders, fishing hooks, fishing scales, fishing scalers, and fishing permit kits, namely kits containing fish hook removers, fishing scales, tow cables, tire deflation devices, tire pressure gauges, portable commodes, first aid kits, fire extinguishers, flashlights, shovels, jacks, jack boards, and carrying pouches" and "mail order catalog sale services featuring fishing equipment." Also of record are three additional third-party registrations of marks for Class 35 services in the field of fishing equipment; these three registrations do not include Class 28 fishing equipment per se.

registration of RETRIEVER TRAINER for "remote control devices for training retrievers, namely, electronic transmitters and receivers," originally cited by the Trademark Examining Attorney as a Section 2(d) bar to registration of applicant's mark (but later withdrawn).⁴

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by determining, under the first *du Pont* factor, whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when

⁴ See *supra* at footnote 2.

subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In terms of appearance and sound, we find that applicant's mark RETRIEVER WORLD and registrant's mark RETRIEVER obviously are identical to the extent that they both consist of or begin with the word RETRIEVER. However, the marks look and sound dissimilar to the extent that applicant's mark includes the word WORLD while registrant's mark does not.

In terms of connotation, we find that the word RETRIEVER in applicant's mark, as applied to applicant's

services, would be understood to mean, or to refer to, the sporting dogs known as "retrievers." We base this finding on the dictionary definition of "retriever" quoted above, and on the fact that applicant's services, as recited in the application, include the marketing and sale of "animal training equipment." Clearly, it was this "sporting dog" connotation of RETRIEVER as applied to applicant's "animal training equipment" that prompted the Trademark Examining Attorney to require (and applicant to supply) the disclaimer of RETRIEVER. Although applicant's recited services also include the sale of hunting gear and fishing equipment, not just animal training equipment, we find that purchasers viewing applicant's mark in connection with applicant's recited services readily will understand the word RETRIEVER as connoting the sporting dogs known as "retrievers."

Our finding that purchasers are likely to ascribe this "sporting dog" connotation to the word RETRIEVER in applicant's mark is bolstered by a review of applicant's advertisements (submitted as specimens of use in the application). See *In re P. Ferrero & C.S.p.A.*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973) (specimens of use are relevant to determination of meaning of mark). It appears from applicant's specimens that the primary focus of

applicant's business is the sale of the "animal training equipment" listed in the recitation of services, and the sale of dog training equipment in particular. Applicant's price list bears the heading "Quality Sporting Dog Equipment," and the products listed for sale appear to consist almost exclusively of such dog training equipment. Directly under the RETRIEVER WORLD mark at the top of the advertisement are the words (in quotation marks and in italic type) "Dedicated to Retrievers and Their Owners."

Next, we find that the word WORLD, as used in applicant's mark and as applied to applicant's services, would be understood to have the meaning set forth in the above-quoted dictionary definitions as entry number **7 b**, i.e., "a distinctive class of persons or their sphere of interest," and/or the meaning set forth as entry number **10**, i.e., "the sphere or scene of one's life and action." The other listed definitions clearly are less pertinent, if not also irrelevant, in the context of applicant's mark as applied to applicant's services. Given the obvious mere descriptiveness of the term RETRIEVER as applied to applicant's services, we find that the word WORLD plays a significant and even dominant role in the commercial impression created by applicant's mark.

Thus, considering applicant's mark RETRIEVER WORLD in its entirety as applied to applicant's services, we find that the mark connotes retriever sporting dogs and the sphere of interests and activities pertaining to or shared by such dogs and their owners.

Turning now to the cited registered mark RETRIEVER, we find that its connotation, as applied to registrant's goods, clearly is dissimilar to the connotation of applicant's mark RETRIEVER WORLD. Registrant's goods are "bowfishing reels." When considered in connection with such goods, the mark RETRIEVER perhaps connotes or suggests that the reel will allow the fisherman to "retrieve" fish, or it might suggest some feature of the reel which allows the fisherman's line, or lure, to be "retrieved" easily.

Although the exact connotation of registrant's mark as applied to registrant's goods is not apparent on this record, it is clear that registrant's mark, unlike applicant's mark, does not connote retriever sporting dogs in any way. We find that this difference in the marks' connotations clearly and significantly weighs against a finding that the marks are confusingly similar. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRYSTAL CREEK for wine has different connotation than CRISTAL for

champagne; marks found to be dissimilar); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (PATIO for Mexican food has different connotation than TAPATIO for Mexican food; marks found to be dissimilar); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras has different connotation than CROSSOVER for ladies' sportswear; marks found to be dissimilar); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for shoes has different connotation than PLAYERS for men's underwear; marks found to be dissimilar); and *Taj Mahal Enterprises Ltd. v. Trump*, 745 F.Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990) (TAJ MAHAL for Indian restaurant has different connotation than TAJ MAHAL for Atlantic City hotel/casino; marks found to be dissimilar).

Having considered the marks in their entireties in terms of appearance, sound and connotation, we find (under the first *du Pont* factor) that they are more dissimilar than similar in their overall commercial impressions. The mere presence of the word RETRIEVER in both marks does not suffice to render the marks similar, especially in view of the fact that the word presents a different meaning and commercial impression in each mark, as applied to the respective goods and services. The presence of the word WORLD in applicant's mark further distinguishes the

appearance, sound and connotation of the two marks when considered in their entirety.

We turn next to the second *du Pont* evidentiary factor, (i.e., "the similarity or dissimilarity and nature of the goods or services"). We find that applicant's services, which involve, *inter alia*, the online, catalog, and retail sale of sporting goods, including fishing equipment, are similar and related to registrant's bowfishing reels. It is settled that confusion is likely to result if the same or similar marks are used for goods, on the one hand, and for services involving those goods, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); see also TMEP §1207.01(a)(ii) and cases cited therein. Applicant's services involve the sale of fishing equipment such as registrant's, and we find that the respective goods and services are related, at least to that extent.

Moreover, although the four third-party registrations made of record by the Trademark Examining Attorney⁵ are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they

⁵ See *supra* at footnote 3.

suggest that the goods or services identified therein (i.e., fishing gear, and the services of selling fishing gear) are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

There are no limitations or restrictions in either applicant's or registrant's identification of goods and/or services, and we therefore presume that those goods and services are marketed in all normal trade channels for such goods and services and to all normal classes of purchasers of such goods and services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Given the above-noted relationship between applicant's services and registrant's goods, we presume that applicant's and registrant's trade channels and purchasers overlap. In fact, in her appeal brief, applicant asserts that she sells registrant's RETRIEVER bowfishing reels. This overlap in trade channels weighs in favor of finding of likelihood of confusion under the third *du Pont* factor, i.e., "the similarity or dissimilarity of established, likely-to-continue trade channels."

Applicant argues that the purchasers of her services and registrant's goods are knowledgeable about those goods and services, and that because they are concerned about the

quality and safety features of their hunting and fishing equipment, they are selective and careful in making their purchasing decisions. However, there is no evidence in the record to support this contention. In any event, we are not persuaded that purchasers of these goods and services necessarily are so knowledgeable or careful that they would be immune to source confusion arising from the use of confusingly similar marks on or in connection with the respective goods and services. We find that the fourth *du Pont* factor, "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing," is neutral in this case, at best.

There is no evidence as to the fame of registrant's mark, and the fifth *du Pont* factor accordingly is neutral in this case. There likewise is no evidence in the record pertaining to the sixth *du Pont* factor, i.e., "the number and nature of similar marks in use on similar goods [and services]." As discussed above, applicant's proffered evidence of such third-party use was untimely-submitted and has not been considered.⁶

⁶ Also, we are not persuaded by applicant's "examination consistency" argument, set forth in applicant's brief under the thirteenth "miscellaneous" *du Pont* factor. Even if applicant had proven the existence on the register of a third party's allegedly confusingly similar mark (and she has not), the existence of such a registration does not warrant registration of another confusingly similar mark to applicant. See, e.g., *AMF Inc. v.*

There is no evidence of any actual confusion (seventh *du Pont* factor). However, under the eighth *du Pont* factor, the absence of actual confusion is not dispositive nor particularly significant in our likelihood of confusion determination in this *ex parte* case. See, e.g., *In re Seiber & McIntyre, Inc.*, 192 USPQ 722 (TTAB 1976). There is no evidence as to the extent of either applicant's or registrant's use of their respective marks. Applicant apparently has used her mark only since 1998. Applicant asserts in her brief that she advertises and sells registrant's bowfishing reels on her website, but that she "is unaware of exactly how long" that has occurred. We cannot conclude from this record that there has been such an opportunity for actual confusion to have occurred that the absence thereof is surprising or legally significant. We find that the seventh and eighth *du Pont* factors are neutral in our likelihood of confusion analysis in this case.

Under the ninth *du Pont* factor ("the variety of goods on which a mark is or is not used"), it appears from this record that registrant uses its RETRIEVER mark only on a

American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *Plus Products v. StarKist Foods, Inc.*, 220 USPQ 541 (TTAB 1983).

single product, i.e., bowfishing reels. Applicant uses her mark only in connection with the online, catalog and retail store services recited in the application, and not as a trademark for any "house brand" goods of her own.

With respect to the tenth *du Pont* factor (the "market interface" between applicant and registrant), applicant asserts in her brief that she has marketed registrant's bowfishing reels for some indeterminate amount of time without any actual confusion, and that although there is no formal agreement between the parties, she "believes that Registrant is aware of Applicant and consents to Applicant's use of RETRIEVER WORLD." However, there is no consent agreement of record, nor any other evidence establishing either that opposer consents to applicant's registration of the mark for the recited services, or that opposer in fact believes that no confusion is likely to result from applicant's use of the mark in connection with the recited services. We accordingly find that the tenth *du Pont* factor does not aid applicant in this case. See generally *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

In summary, we have carefully considered all of the evidence of record pertaining to the *du Pont* likelihood of confusion evidentiary factors, and we conclude that there is no likelihood of confusion in this case. Applicant's

services and registrant's goods (and the trade channels and purchasers therefor) are related to the extent that applicant's services could involve, and apparently do involve, the marketing of registrant's goods, and those *du Pont* factors weigh in favor of a finding of likelihood of confusion. However, notwithstanding the relationship between the respective goods and services, we conclude that the marks are too dissimilar to warrant a finding of likelihood of confusion, and that the first *du Pont* factor accordingly is dispositive in this case. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards, supra*; *Kellogg Co. v. Pack'em Enterprises*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Specifically, because the connotation and commercial impression of applicant's mark would be perceived, understood and recalled as having to do primarily with retriever sporting dogs, and because registrant's mark as applied to registrant's goods has no such connotation or commercial impression, we find that purchasers are not likely to assume that a source connection exists as between applicant's services and registrant's goods.

Decision: The refusal to register is reversed.